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EXAMINER	
LE, KHANH H	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	10/748,682	KONINGSTEIN, ROSS	
	Examiner	Art Unit	
	KHANH H. LE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-118* is/are pending in the application.

4a) Of the above claim(s) *84-118* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24,26-58, 60-83* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/10/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the response filed 05/21/09. Claims 1-118 were pending. The Applicant elected, with traverse, the invention of Group 1, directed to claims 1-33, 34-64, 65-75, and 76-83. Thus Claims 84-118 were withdrawn from consideration. Claims 25 and 59 are being cancelled. Thus claims 1-24, 26-58, 60-83 are herein examined. Of these, claims 1 (method), 34 (apparatus), 65 and 76 are independent. Claims 1- 24, 26-58, and 60-83 are amended.

Priority

2. Applicant's claim for the benefit of prior-filed application Provisional Application SN 60516281, filed 11/03/2003) under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See Transco Products, Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Morphing is not disclosed in Application No. 60516281. Accordingly, claims 1-33, 34-64, 65-75, and 76-83 are not entitled to the benefit of the prior application.

Since this application repeats a substantial portion of prior application No. 60516281 and adds and claims additional disclosure not presented in the prior application and names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78. It is noted that the specification and the oath would have to be corrected accordingly.

Claim objections

3. Prior objections to Claims 45-47, 49, 57, 70, 72, 81 are withdrawn following proper corrections.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Prior rejections of claims 6-7, 25, 38-39, 34 -64 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are withdrawn.

6. However, amended claims 34-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 recites an apparatus comprising "a server performing operations comprising receiving, …delivering… " . "performing operations comprising receiving, …delivering… " is directed to methods. **Thus claim 34 is mixing apparatus and method limitations thus the claim scope is unclear. Appropriate correction is required.**

Claims 35-64, dependents of claim 35, are rejected based on their dependency.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8a. Prior rejections of Claims 1-33 under 35 U.S.C. 101 as directed to non-statutory subject matter are withdrawn following proper corrections. Claim 1 now includes delivering from a server to a user device a morphing advertisement allowing alternate display formats, which is considered core to the invention.

8b. Method claim 65 is considered statutory because "displaying the first display format of the morphing advertisement in the electronic document at the end user system" involves the end user system which is considered a machine. Claims 66-75, dependents of claim 65, are statutory based on their dependency on claim 65.

8c. Prior rejections of Claims 34-64 under 35 U.S.C. 101 as directed to non-statutory subject matter are withdrawn following proper corrections. Claim 34 now includes a server performing operations and is considered structure.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-12, 26, 28, 34-43, 56, 58, 60, 65-70, 71, 73 -74 and 76-80, 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos).

Claims 1, 34, 65 and 76:

Petropoulos discloses:

A computer-implemented method for advertising in an electronic document, the computer-implemented method comprising the steps of:

storing a plurality of advertisements associated with one or more subject matters of interest to users, the plurality of advertisements comprising at least one morphing advertisement (Fig 1, items 60, 53, 54 are morphing ads in a search result lists; Fig 7, item 753: data store; [0073]: search results made of documents or webpages relevant to a subject searched are interpreted to include advertisements which are stored in data store 753);

receiving a request for one or more advertisements related to a subject matter of interest (Fig 7, item 751; [0073]);

delivering at least one morphing advertisement, the morphing advertisement including instructions to enable an end user system to change from a first display format to a second display format different from the first display format based on one or more user requests to display the second display format (Fig 1, items 60, 53, 54 are morphing ads in a search result lists because mousing over or clicking them (i.e. using embedded instructions) allows viewing preview information such as image 57 of Figure 1 (which reads on the second display format) see e.g. abstract, [0025]) or can be lists of URLs that can be expanded further or sortable webpages (which also read on the second display format) (see [0026-0027]; [0029]). Also see [0042] which discusses preview window 55 of Fig 1 (which also reads on the second display format) obtained by mousing over a first display format such as Fig 1, items 60, 53, 54.

Response to arguments

Applicant argues that Petropoulos's describing of allowing a user to see both a search result and a preview of the underlying information described by the search result (i.e., a preview of the webpage linked to by the result) is different from representative claim 1. Citing Petropoulos specifically at [0023], Applicant argues Petropoulos's search result and the (prompted and linked) preview window are two different elements delivered at different times, thus different from the claims, which claim that " two instances of an advertisement as well as the instructions are delivered as part of one advertisement".

Next Applicant argues Petropoulos's instructions are also delivered at a different time. That is, it is argued, Petropoulos's 2 formats and the instructions, "are delivered sequentially at three different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result instructions are delivered, and then the preview information is delivered)." (Resp. at 21). It is also understood, Applicant further argues that neither Petropoulos's search result nor the associated preview includes 2 instances of the same advertisement as claimed (Resp. at 21, 1st full paragraph).

The Examiner notes, first, there is an interpretation issue. Thus representative claim 1 will be interpreted.

Interpretation:

Representative Claim 1 recites in part **"delivering at one time,** from a server to an end user device, at least **one morphing advertisement** in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement including a first instance being a compact display format, a second instance being an expanded display format, **and instructions to enable the end user system to initially display** the morphing advertisement in the compact display format **and to transition the** morphing advertisement from the compact display format **into the expanded display format** upon a user request to display the expanded display format while no longer displaying the compact display format."

An instance is "a step, stage, or situation viewed as part of a process or series of events". See instance. (2009), entry 4. In Merriam-Webster Online Dictionary. Retrieved August 25, 2009, from http://www.merriam-webster.com/dictionary/instance.

Instances are not specifically disclosed in the specification though two formats of the same ad is disclosed, and transition from one format to the other is. (Support for claim 1 can be found in original claim 65 (morphing ad comprising both formats and instructions), See Specification paragraphs [0007], original claims 1, 34, 25, 56, 27, 57. Instructions to allow expanding from compact to expanded format are disclosed at Spec. [0030], [0031], Figs 1-2. Covering the compact format is disclosed at Figures 1-2).

Thus for prior art application purposes, by "instances", it is simply interpreted that the morphing advertisement includes instructions to enable the end user system to initially display the morphing advertisement in the compact display format (i.e. at a first instance) and to transition the morphing advertisement from the compact display format into the expanded display format (i.e. at a second instance) upon a user request to display the expanded display format.

Thus, in other words, claim 1 is only directed to delivering to the user device the morphing ad inside a publisher webpage and instructions to enable morphing from a compact format to a morphed expanded format.

(Note: The best support for delivering to the user the advertisement including both formats and the instructions **at the same time**, as argued, is with original claim 65 which only recited:

"65. A computer-implemented method for advertising in an electronic document, the computer-implemented method comprising the steps of: ***receiving an electronic document at an end user system****, the electronic document* ***including one or more morphing advertisements, the morphing advertisement*** *comprising a first display format, a second display format* ***and***

instructions for enabling *an end user system to display both formats; displaying the first display format of the morphing advertisement in the electronic document at the end user system; receiving a user request to display the second display format; and displaying the second display format in the electronic document."*

Since claim 65 only discloses "the morphing advertisement comprising a first display format, a second display format " without further details (note that comprising is a broad term), it is understood that claim 65 only means that the morphing advertisement may be presented in a first display format then in a second display format**. Specifically the Examiner notes that claim 65 does not disclose that any particular data as to the 2 formats have been received by the user system)**

Morphing ad is not specifically defined. Transition is not specifically defined. No special transitional effects are disclosed.

Thus the delivering step of claim 1 is interpreted as "delivering at one time, from a server to an end user device, at least one morphing advertisement in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement including instructions to enable the end user system to initially display the morphing advertisement in a compact display format (i.e. at a first instance) and to transition the morphing advertisement from a compact display format into an expanded display format (i.e. at a second instance) upon a user request to display the expanded display format while no longer displaying the compact display format."

(Note: If Applicant does not agree with this interpretation Applicant is requested to supply specific support showing what constitutes 2 instances of the ad delivered at the same time.)

Thus when Applicant argues Petropoulos's search result and the (prompted and linked) preview window are two different elements delivered at different times, thus different from the claims, (Applicant argues the claims are that "two instances of an advertisement as well as the instructions are delivered as part of one advertisement"), Applicant seem to be confused because in fact Applicants' s 2 formats are also displayed sequentially.

As stated above, the instant specification discloses 2 formats of a morphing ad, displayed sequentially. However "two instances" of the same ad are not mentioned in the specification, thus not specifically defined, and thus interpreted above as 2 formats sequentially displayed at two different times, i.e. instances. Thus Petropoulos's search result and the (prompted and linked) preview window displayed sequentially are equivalent to the 2 formats claimed.

(Note also that an "advertisement" is just a data file. The claimed 2 formats are part of the data file. The instructions to enable transition is part of the data file. In PETROPOULOS the 2 formats can be seen as the same advertisement data file. PETROPOULOS's instructions such as the preview icon is also part of that data file which is sent with the publisher webpage).

The examiner specifically notes that nowhere in the specification is" morphing ad" defined as an animation type ad or as having fading effects , thus, under the broadest interpretation rule to be applied during examination, "transition into" is *not* interpreted as animation or fading.

Thus, as noted above, the delivering step of claim 1 is simply interpreted as "delivering at one time, from a server to an end user device, at least one morphing advertisement in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement including instructions to enable the end user system to initially display the morphing advertisement in a compact display format (i.e. at a first instance) and to transition the morphing advertisement from a compact display format into an expanded display format (i.e. at a second instance) upon a user request to display the expanded display format while no longer displaying the compact display format."

Thus since the PETROPOULOS's preview window gives details about the search result, and both concern the same subject matter, both are interpreted as concerning, and thus as being, part of the same advertisement. The search result is interpreted as the compact format of the advertisement while the preview is interpreted as the expanded format of the same advertisement. **Thus contrary to argument, the PETROPOULOS's search result is an advertisement which can be expanded into a preview pane thus its delivery from the server to the user reads on "delivering from a server to an end user device, at least one morphing advertisement in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement capable of transitioning from a compact display format (i.e. at a first instance) into an expanded display format (i.e. at a second instance) upon a user request to display the expanded display format.**

Note that even if it is interpreted that data re. the formats are sent as well as the instructions to enable transitioning , PETROPOULOS still disclose those: the advertisement is considered a file or set of files, comprising the totality of format 1 (search result) and format 2 (preview window) and functionalities such as the expansion icon.
Format data re the 1st format being sent with the ad is inherent to be able to render format 1.
Instructions to transition is e.g. the expansion icon, also inherently sent with the ad so to be displayed with format 1 *([0023] "The defined areas are program-designated (perhaps with JavaScript) areas on results page 59":* the program designating the mouse over area is interpreted as such instructions).
Format 2 data is also interpreted as sent with the ad : "embedded preview window" suggests some data about the preview window was delivered with the publishers webpage.

Since the publishers webpage was delivered with the search result (1st format) and data re. the instructions as well as re. the 2nd format are also on the publishers webpage, thus all 3 components of the ad are delivered together.

Contrary to argument, notwithstanding that some other instructions may be also sent to open the embedded preview window" in the cited part, nonetheless **PETROPOULOS** 's [0023] *"The defined areas are program-designated (perhaps with JavaScript) areas on results page 59"* still reads on enabling the transition from format 1 to format 2. :

> *[0023] Referring back to search-result page 59 as a whole, recall that this is a result returned after a user has performed a search on the term "Jet." The user must then analyze those results and will typically do so using the combinations of keystrokes and the pointer tool. A feature of the current invention is that the user is shown preview information when the mouse pointer 52 navigates or passes over a defined area such as first defined area 60, second defined area 61, or other defined areas 62, 64, 66, 67, 68 (Hereinafter, the action of navigating or passing the mouse pointer over a region is referred to as a "mouse-over"). The defined areas are program-designated (perhaps with JavaScript) areas on results page 59. While these defined areas could be made visible, they are generally invisible to the user. In one embodiment, upon a pre-defined placement or action of the pointer (e.g. a mouse-over), instructions are sent to the user's web browser to automatically open an embedded preview window and render the relevant contextual information inline with the user's results. In various implementations of the invention, defined areas may be in any shape or size, located anywhere on the page and may be configured by a programmer, the user, or any process with sufficient access to the system.*

PETROPOULOS does not disclose displaying the "expanded display format while no longer displaying the compact display format."

However PETROPOULOS discloses different embodiments of the preview window. The preview window may cover "whatever information is below it on the (results) web page." .. "either completely, in opaque fashion or semi-translucent fashion. ". See [0049] and Fig 3.

Further PETROPOULOS discloses expansively, at [0042],

"The invention contemplates that the preview information may be displayed in any manner that the client system may facilitate. ... the preview information may also be displayed in one or more new browser windows opened under or over the current window or in a window which already exists on
results page 59 such as preview window 55, which can be located anywhere on results page 59.... , the invention

contemplates that the user can dynamically control the location of the preview window, its size and the duration of its visibility. "

Thus in view of PETROPOULOS's teachings of the many formats (e.g. in size, location, duration, opacity) that the preview window can take, it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") that, if desired, the preview window can be made to opaquely cover the initial search result (the 1st advertisement format), thereby "displaying the expanded display format while no longer displaying the compact display format." as claimed. One would be motivated to cover the search result if one needs or wants to expand the preview window to increase readability and such need or desire results in covering the search result.

PETROPOULOS further discloses:

claims 2, 35, 66, and 77 (dependent on claims 1, 34, 65 and 76):
wherein the second display format comprises additional information about the item being advertised compared to the first display format (see e.g. [0042]: e.g. hyperlinks in preview window allows retrieving more information; [0010]);

claims 3, 36 (dependent on claims 2, 35):
wherein the additional information comprises one or more images (see e.g. [0032]; Fig 1, item "57");

claims 4-5, 37 (dependent on claims 2, 36):
wherein the additional information comprises menu options comprising a link to at least one other web page that enable the user to request additional content(e.g. [0028]; [0029]: see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]: more search results reading on a menu; [0032]: preview information can be an advertisement with inherent links; [0042]: preview information include hyperlinks for mouse over or click on; or [0054], user may initiate a menu or control system for controlling the function of the available preview functions);

claims 6, 38 (dependent on claims 4, 37):
wherein the options, upon selection, retrieve web content specified in association with the morphing advertisement delivered (e.g. [0028]; [0029]: see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]: more search results);

claims 7, 39 (dependent on claims 6, 38):

wherein the content retrieved comprises content provided by or affiliated with a host entity that performs the storing, receiving and delivering steps ([0025-26], preview information displays actual content or the web page referred by or associated with the first result delivered by the host entity; or [0029]: further contextual information re. URL pertaining to web page);

claims 8-9, 40, 67 and 78 (dependent on claims 2, 35, 65 and 76):
wherein the additional information comprises audio elements ([0043]) or an animation ([0043]: "any other sensory information" reads on including animation);

claims 10, 41, 68, and 79 (dependent on claims 1, 34, 65 and 76):
wherein the one or more user requests comprises selection of an expansion icon presented as part of the first display format ([0037]-[0038]: preview icons, Fig. 1, items 63 or 64, used to open (i.e. expand to) preview pane 57 when moused over or clicked);

claims 11, 42, 69, and 80 (dependent on claims 1, 34, 65 and 76):
wherein the one or more user requests comprises a mouse-over of the first display format (e.g. [0038], user mousing over display icon to open preview display; or [0036]: mousing over defined area 60 of Fig 1 opens webpage 57);

claims 12, 43, and 70 (dependent on claims 1, 34, and 65): wherein the one or more user requests (interpreted as "to display the second format") comprises a preference specified by the user ([0038], line 5: "user options" or [0042]: user may control attributes of preview window).;

claims 56, 71 (dependent on claims 1, 34, and 65):
wherein the instructions include data sufficient to enable the end user system to display the contents of the second display format (Petropoulos implicitly discloses such instructions to allow interpreting user action such as mouse over of the electronic ad and displaying the second display format, as discussed in e.g. [0042]: preview information displayed over the current window or in a window which already exists on results page such as a preview window that can be located anywhere on the results page);

claim 26 (dependent on claims 25)
wherein the second display format comprises a graphic (e.g. Fig 1 item 57);

Claims 28, 58, 73 -74 and 82-83 (dependent on claims 1, 34, 65, 76):
wherein the second display format covers different area in an interface of the end user system than the first display format (e.g. Figs 2 or 3, preview window is different from search

results window that reads on first display format as well); wherein 2nd display format covers more area than 1st display format (for claims 82, 73) (Petropoulos, e.g. [0027]; [0037]); wherein 2nd display format covers one or more advertisements (for claims 74, 83) (Petropoulos, e.g. [0027]; [0037]);

Claim 60 (dependent on claim 44): wherein the second display format covers a different location than the first display format (e.g. location of Fig 1 item 55 (2nd display format) as compared to location of items 53, 54 (first display format)).

11. Claims 33, 64, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos).

Claims 33, 64, and 75 (dependent on claims 1, 34, and 65):

Petropoulos further discloses second display formats are approved prior to being delivered ([0042], last few lines: filtering (i.e. approval) for content appropriateness in second display formats before transmission; [0032], last sentences: web page creators control second display formats with tags).

However PETROPOULOS does not explicitly disclose such controls or approval applicable to the first display formats.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to apply the same controls or approval that PETROPOULOS teaches as to the second format, to the first display formats, for the same disclosed advantages.

12. Claims 27, 57, 72, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos as applied to claims 26, 56, 71, or 76 in view of Housman et al., US 20030224340.

Claims 27, 57, 72, 81 (dependent on claims 26, 56, 71, 76):

Petropoulos discloses claims 26, 56, 71, 76 wherein the second display format comprises a graphic (e.g. Fig 1 item 57); however it does not disclose wherein the instructions include an instruction to preload the graphic before an end user request to display the second display format.

However Housman teaches preloading requested images would increase display speed ([0054]).

Thus it would have been obvious to a PHOSITA to add this Housman teaching to Petropoulos because "[t]his obviously is much faster than having the user wait for his

potentially-slow communications link to download the next requested answer" (Housman, [0054]).

13. Claims 13-24, 44-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETROPOULOS as applied to claims 1 or 34 above, and further in view of Meisel 7035812.

Claims 13, 44:

PETROPOULOS discloses a method as in Claim 1 or 34 above and discloses monitoring user interaction with the preview information (including length of interaction; clicks: [0073]) in order to revise the original rankings (based on relevance) of search results ([0072]-[0079]).

PETROPOULOS does not explicitly disclose search results ranked by monetary considerations, thus does not explicitly disclose:

storing a price parameter (in association with one or more advertisements) (interpreted as e.g. a cost per click or CPC) for certain performance by end users viewing the advertisement (interpreted as e.g. a click);

and upon receiving a request for an advertisement, determining one or more advertisements to deliver based at least in part on the price parameter (associated with a plurality of advertisements associated with the subject matter of interest).

But Meisel does (see e.g. abstract: "bid amount" is interpreted as cost per click).

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to add Meisel's bidding system to PETROPOULOS to allow also ranking search results based monetary considerations.

Claims 14, 45 (dependent on claims 13, 44):

Note: "granting a ranking bonus for morphing advertisements" is interpreted as giving advertisers a bonus in order to encourage them to use morphing ads as per specification at paragraph [0093].

PETROPOULOS and MEISEL disclose a method as in Claim 13, 44 above and but neither discloses granting a ranking bonus for morphing advertisements in determining the one or more advertisements to deliver.

Official Notice is taken that is old and well-known at the time of the invention to give incentives to encourage customers to try new products or services or new features thereof. See e.g. Partovi, US 20020126813 A1 (abstract: incentives for trying new phone features).

Thus in the search listings business, since ranking is valuable to advertisers, it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to give an incentive tied to rankings to encourage advertisers to use the new form of morphing advertisement until they can be convinced of its effectiveness.

Claims 15, 46 (dependent on claims 13, 44):

PETROPOULOS and MEISEL disclose a method as in Claims 13, 44 above. PETROPOULOS does not but Meisel does teach the determining step determines ranking of advertisements based on an effective revenue per impression determined based on bid amount and click-through-rate ("effective revenue per impression" is interpreted as a product of click through rate and cost per click, also called ecpm or ecpc. Meisel at col. 19 lines 45-55: each bid can be expressed in units of ecpm or ecpc. Since ranking in Meisel is based on bids, thus ranking is based ecpm or ecpc). Thus it would have been obvious to a PHOSITA to add this feature of Meisel to PETROPOULOS to allow ranking per effective revenue per impression.

Claims 16-17, 47-48:

PETROPOULOS and MEISEL disclose a method as in Claims 15, 46 above. Neither teach comprising the step of granting a bonus for morphing advertisements by taking an action causing a change to (or enhancing) the effective revenue per impression (or a price parameter) for the morphing advertisement.

Official Notice is taken that is old and well-known at the time of the invention to give incentives (or bonuses) to encourage customers to try new products or services or new features thereof. See e.g. Partovi, US 20020126813 A1 (abstract: incentives for trying new phone features).

Thus in the search listings business, since ads ranking is valuable to advertisers, and since ecpm (effective revenue per impression) determines rankings (see Meisel in discussion of claim 15 and 46 above), it would further been obvious to a PHOSITA that the bonus could be expressed in advantageous ecpm terms, (e.g. by increasing the ecpm for a particular ad based on which its ranking is determined without increasing the charge to the advertiser) thereby advantageously affect the rankings for ads using the new morphing ad format.

Claims 18, 49:

PETROPOULOS and MEISEL disclose a method as in Claims 17, 48 above. Neither explicitly teaches wherein the advertiser is charged based on the price parameter but not the increased price parameter value when the morphing advertisement achieves one or more performance parameters (e.g. when the end user clicks on a morphing ad). However as discussed

above in claims 16-17, 47-48, a bonus is given to advertisers to try the new morphing ad format, in forms of an enhanced ecpm that advantageously influence that ranking. Thus it would have been obvious to a PHOSITA that the advertiser of PETROPOULOS and MEISEL should only be charged the price parameter based on her bid (and not the enhanced or increased price parameter value), otherwise the bonus would have been negated.

Claims 19, 50:

PETROPOULOS and MEISEL disclose a method as in Claims 13, 44 above. Neither explicitly teaches the advertiser is charged an increased amount for a morphing advertisement. However it would have been obvious to a PHOSITA to charge more for the morphing advertisement if it later proves to be an effective format and demand from advertisers allows, and/or its cost of production justifies, increasing its price.

Claims 20-21, 23, 51-52, 54:

PETROPOULOS and MEISEL disclose a method as in Claims 13, 44 above. Neither explicitly teaches calculating an amount owed by an advertiser associated with an advertisement based on the advertisement meeting a performance parameter associated with the morphing advertisement, wherein the performance parameter is determined based on user activity associated with the second display format, or based on user request to view the second display format.

However PETROPOULOS teaches tracking user behavior pertaining to the second display format (i.e. a performance parameter is met as to the morphing ad and/or second display format) ([0042]:" functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page";[0073]; also see ([0026], preview information include URLs as links; [0054]: menu or control system for controlling the function of the available preview functions).

Further Meisel teaches billing advertisers based on their bids (abstract).

Thus it would have been obvious to a PHOSITA, in the PETROPOULOS and MEISEL system, to bill the advertiser (or calculate an amount owed by an advertiser as claimed) when an end user interacts with (e.g. by clicking) the morphing ad and the second display format of the system (i.e. based on the morphing advertisement meeting a performance parameter as claimed) in order to collect revenues for the ad service.

Claims 22, 53:

PETROPOULOS and MEISEL disclose a method as in Claims 21, and 52 above. Neither explicitly teaches the billing is based on the user activity comprising a predetermined

period of time viewing the second display format. However Petropoulos further discloses wherein the user activity comprises a predetermined period of time viewing the second display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user's use of preview information monitored including the length of each preview, a long duration indicates high relevancy to a particular result). Further billing an advertiser for an amount of time the user interacts with an advertisement is old and well-known at invention time (e.g. see Faber, US 20050114210 , at [0070]). Thus in the system of PETROPOULOS and MEISEL, it would have been obvious to a PHOSITA to charge advertisers based on a predetermined time of user interaction (as is well-known) and which can be tracked as taught by PETROPOULOS for the purpose of billing based on this well-known measurable value basis.

Claims 24, 55:

PETROPOULOS and MEISEL disclose a method as in Claims 21, and 52 above. Neither PETROPOULOS or MEISEL teaches the user activity comprises a predetermined number of user selections of menu options, navigational links or other controls available in the second display format. However Petropoulos discloses wherein the user activity comprises a predetermined number of user selections of the one or more menu options available in the second display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs will function as links, see also [0054], user may initiate a menu or control system for controlling the function of the available preview functions).

Thus in the system of PETROPOULOS and MEISEL, it would have been obvious to a PHOSITA to charge advertisers based on all the user behaviors cited above which can be tracked in PETROPOULOS for the purpose of billing based on specified user behavior which may indicate different levels of interaction with the morphing ad and/or second display format which may be of different values to the advertisers.

14. Claims 29-32, 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETROPOULOS in view of Meisel and further in view of Telagon, US 20030135460.

Claims 29-32, 61-63:

PETROPOULOS discloses a method as in Claims 28, 34 above and MEISEL further discloses an ad priority scheme based on bid prices (see discussion at paragraph 13 above) thus the combination of PETROPOULOS and MEISEL discloses the steps of: storing a price parameter value in association with one or more advertisements when the advertisement meets one or more performance parameters with respect to the end user; upon receiving a request for an advertisement, determining one or more advertisements to deliver , in a priority scheme, based at

least in part on the price parameter associated with a plurality of advertisements associated with the subject matter of interest; and wherein the step of determining includes assessing whether to deliver a morphing advertisement based on the price parameter of the morphing advertisement (citations and discussion at paragraph 13 above).

PETROPOULOS and MEISEL do not disclose delivery of the morphing advertisement is also based on:

"the price parameter value of at least one other advertisement and at least one area-based parameter" ; or

further "wherein the area-based parameter comprises the price parameter value of at least one advertisement that the second display format would cover upon user request"; or

wherein the morphing advertisement may cover one or more other advertisements, the price parameter value associated with each other advertisement that the second display format covers plus a premium amount.

However Telagon, in a system for valuing and placing ads, teaches the concept that an advertiser paying more should have more exposure within a limited ad space ([0039]; [0045]). Telagon gives the example that if there are 6 ad segments or displays available within an ad space, an advertiser bidding $20 while four others bid $10 dollars each, should get two/sixth of the available ad segments [0045].

Thus Telagon teaches the ad price is directly proportional to the ad space covered by the ad i.e. proportional to the real estate used by the ad. Thus it would have been obvious to a PHOSITA to add this concept taught by Telagon to PETROPOULOS and MEISEL in order to fairly price the advantage given to an expanding ad that covers other ads. It would further have been logical and thus obvious that if an ad, e.g. ad #1, should expand and cover another ad (e.g. ad#2) then that ad #1, would also have to pay, in addition to its own bid price, the price that ad #2 would otherwise have fetched, because of the benefit to ad #1 and the detriment to ad #2. By the same token if further expansions of ad#1 are requested thus covering other ads (e.g. ad#3 to ad #n), it would have been further obvious to a PHOSITA, that the charge to ad #1 should and could be increased to cover the bids of ad#3 to ad #n , again because of the benefit to ad #1 and the detriment to ad #3 to ad #n. (Also since duplication of parts has been held obvious, here, duplication of charges for ad #3 to ad #n would have been obvious as mere duplications of charges of ad #2).

Further it is well-known parties to a contract can agree to any contractual terms, including compensation terms, for any purpose. Thus to add a premium as claimed would have been an obvious matter of design choice, only subject to agreement by the parties, for the purpose, e.g. to make a better profit for the ad service.

Response to Arguments

15. Applicant's arguments filed 05/21/09 have been considered but are not persuasive. They are addressed in the prior art rejection section above and with the new ground(s) of rejection, presented above.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murray 6061659 discloses messages including platform-independent application objects (applets written in JavaScript) used to morph within the content when displayed. The applets reside on the server as a component of the message and are downloaded with the message to the client browser.

Murray 6243104 discloses, at col. 8 lines 51-55, morphing ads going from a compact format to an expanded format which "fully carries out the message" ("Alternatively, one or more messages may be configured to require consumer on-line interaction with the message, such as by requesting a user to "click-on" an icon, which may then morph to fully carry out the message.")

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Wednesday 9:00-6:00. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Robert A. Weinhardt can be

reached on 571-272-6633. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/
Examiner, Art Unit 3688
October 13, 2009